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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,083	12/11/2003	Shigeru Miki	362-86	8465
33769 7590 05/01/2008 BODNER & O'ROURKE, LLP 425 BROADHOLLOW ROAD, SUITE 108 MELVILLE, NY 11747				
EXAMINER				
NEGRON, WANDA M				
ART UNIT		PAPER NUMBER		
2622				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/733,083

Applicant(s)

MIKI, SHIGERU

Examiner

WANDA M. NEGRON

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The amendment filed on 1/28/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- Page 4, lines 9 and 11-12 of the amendment to the specification recite "at most equal to (i.e., less than or equal to)", which is considered new matter because the specification as originally filed does not support a condition of being equal to 100 as a condition to be met in step S11 in order to proceed to step S13 or a condition of being equal to 50 as a condition to be met in step S11 in order to proceed to step S15.
- Page 5, lines 2-3 and 6 of the amendment to the specification recite "at most equal to (i.e., less than or equal to)", which is considered new matter because the specification as originally filed does not support a condition of being equal to 100 as a condition to be met in step S11 in order to proceed to step S13 or a condition of being equal to 50 as a condition to be met in step S11 in order to proceed to step S15.
- Page 5, lines 16-17 and 19-20 of the amendment to the specification recite "at most equal to (i.e., less than or equal to)" which is considered new matter because the specification as originally filed does not support a condition of being equal to 64 Mbytes as a condition to be met in step S11' in order to proceed to

step S13' or a condition of being equal to 32 Mbytes as a condition to be met in step S11' in order to proceed to step S15.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended **claim 1**, in lines 8-9, recites "and at most equal to the first recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the first recording medium capacity size" as a conditioned to be examined when setting the unit areas to a second unit area size.

Amended **claim 6**, in line 9, recites "and at most equal to the first recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the first recording medium

capacity size" as a conditioned to be examined when setting the unit areas to a second unit area size.

Newly added **claim 11**, in line 3, recites "and at most equal to the first recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the first recording medium capacity size" as a conditioned to be examined when setting the unit areas to a second unit area size. In addition, **claim 11**, in line 6, recites "and at most equal to the second recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the second recording medium capacity size" as a conditioned to be examined when setting the unit areas to a third unit area size.

Newly added **claim 15**, in line 4, recites "and at most equal to the first recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the first recording medium capacity size" as a conditioned to be examined when setting the unit areas to a second unit area size. In addition, **claim 15**, in line 9, recites "and at most equal to the second recording medium capacity size", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the second recording medium capacity size" as a conditioned to be examined when setting the unit areas to a third unit area size.

Newly added **claim 18**, in line 11, recites "and at most equal to the first threshold number of recordable frames", which is considered new matter because the

Art Unit: 2622

specification as originally filed does not support a condition of being "equal to the first threshold number of recordable frames" as a conditioned to be examined when setting the unit areas to a second unit area size. In addition, **claim 18**, in lines 15-16, recites "and at most equal to the second threshold number of recordable frames", which is considered new matter because the specification as originally filed does not support a condition of being "equal to the second threshold number of recordable frames" as a conditioned to be examined when setting the unit areas to a third unit area size.

Any claim not specifically addressed above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Response to Arguments

Applicant's arguments, see pages 16-17, filed on 1/28/2008, with respect to claims 1-9 have been fully considered and are persuasive. The prior art rejections of claims 1-9 has been withdrawn. More specifically, Applicant's arguments regarding a "comparison of either the capacity of the recording medium or the recordable number of frames to a first threshold,... and from this comparison, determining and adjusting the cluster size" are persuasive.

Allowable Subject Matter

Claims 1, 6, and 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Watanabe (US Patent No. 6,002,835) discloses, *inter alia*, detecting a recording medium capacity and determining the image subsampling ratio on the basis of the results of said detection.
- Otsuka et al. (US Patent No. 5,454,096) disclose, *inter alia*, a storage management system wherein the capacity for a storage area of a memory card is detected and managed using a MAT.
- Duruoz (US Patent No. 6,804,746) discloses, *inter alia*, a system for optimizing data storage and retrieval by an A/V system using different tables.
- Roberts et al. (US Patent No. 6,496,222) disclose, *inter alia*, a digital camera including a digital memory system having a control unit for checking for proper format initialization of a removable digital memory element and for performing format initialization when necessary.
- Auld et al. (US Patent No. 6,088,391) disclose, *inter alia*, a memory system comprising a memory organized into a plurality of segments for storing the pixel data, where the number of segments equals the number of frame sections plus two additional segments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WANDA M. NEGRON whose telephone number is (571) 270-1129. The examiner can normally be reached on Mon-Fri 6:30 am - 4:00 pm alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wanda M. Negrón/

Examiner, Art Unit 2622
April 25, 2008

/David L. Ometz/

Supervisory Patent Examiner, Art
Unit 2622